# The second count gives for the first of the

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant

Pacifici

Serial No.

T.B.A., a continuation of

U.S.S.N. 09/201,977

Examiner:

T.B.A.

Filed

herewith

Group Art Unit: T..B.A., formerly 3722

For:

SHEET PREPARED FOR THE BINDING AND ADHESIVE

BAND FOR BINDING LOOSE SHEETS

# **PRELIMINARY AMENDMENT**

### EXPRESS MAIL NO.: EF 321688654US

Assistant Commissioner for Patents Washington, D.C. 20231
Box Continuation

Sir:

Applicant has received an Advisory Action relating to United States Patent

Application No. 09/201,977, in which it was indicated that claim amendments attempted after a

final rejection would not be entered because, according to the Examiner (Ms. Monica Carter),
they raised new issues for consideration. Because Applicant has filed a Notice of Appeal
regarding U.S.S.N. 09/201,977, the due date for the filing of an Appeal Brief by Applicant is
today, May 22, 2001. In lieu of filing said Appeal Brief, Applicant files herewith a continuation
of U.S.S.N. 09/201,977. Prior to the examination of said continuation application, please enter
the following amendments and remarks into the record; the amendments render the title,
specification, and claims in the form which they would have had if the amendments attempted
after final rejection of the parent case had been entered.

NY02:326415 1

1

### **AMENDMENTS**

### IN THE TITLE:

Please replace the current title with "METHOD AND COMPOSITIONS FOR BINDING LOOSE SHEETS"

## **IN THE SPECIFICATION:**

Please insert, before the first paragraph of the application, the paragraph:

-- This application is a continuation of United States Patent Application No. 09/201,977, filed December 1, 1998, now abandoned, which claims priority to Italian Patent Applications Nos. RM97-U/000262 and RM97-U/000263, both filed December 1, 1997. This application incorporates herein the entirety of United States Patent Application No. 09/201,977 by reference.

Please replace paragraph 80 at page 7 lines 5-8 of the specification with the following replacement paragraph:

-- In figures 14, 15 and 16 and 17 and 18, it can be seen the sheet 41 for continuous feeding, wherein the glue or both sides adhesive tape strip 42, along with the silicone band 43, is provided on the upper side of the alternated sheets, instead of on the lateral edge. --

Please replace paragraph 88 at page 7 line 35 through page 8 line 2 of the specification with the following replacement paragraph:

-- Whichever is its structure, band 201 according to the invention, preferably comprised of protection silicone material releasable by the various glues employed, provides a glue zone 202 to be placed on the sheet 203 (see figures 22 and 23 and 24) for coupling with the same in the application zone 204 (see figure 25). --

Please replace paragraph 89 at page 8 lines 3-7 of the specification with the following replacement paragraph:

-- On the continuous band 201, at the end of the glue zone 202, a zone 205 without glue is provided, for the subsequent removal of the silicone material band, followed by a zone 206 serving to reveal, by apparatus or visually, the end of a band section and the beginning of the following one to be applied on another sheet 203.--

### IN THE CLAIMS:

Please amend the claims as follows:

1. (amended) A sheet for permanent binding to one or more additional sheets, having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges, and a silicone material band, releasably placed on said glue or adhesive tape strip and having at least a portion not coupled to said glue or adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal and the binding.

- 2. (amended) The sheet according to claim 1, having an adhesive strip and a releasably placed silicone band on opposite surfaces.
- 3. (amended) The sheet according to claim 1, wherein an adhesive strip is provided on an edge selected from the group consisting of an upper edge, a lower edge, and a lateral edge.
- 4. (amended) The sheet according to claim 1, wherein an adhesive strip is close to the edge of the sheet.
- 5. (amended) The sheet according to claim 1 as comprised in a continuous snap out of sequential sheets, provided with lateral dragging bands, wherein the uncoupled portion of the silicone band is coupled by weakening lines with the band of the following sequential sheet.
- 6. (amended) The sheet according to claim 1 wherein a portion of the silicone band is larger than said glue or adhesive tape strip, and can be folded outwardly during bonding, said portion of the silicone band larger than the glue or adhesive tape strip being the uncoupled portion.
- 7. (amended) A method for irreversibly binding at least two sheets together, comprising:
  - (i) superimposing the sheet according to claim 1 over a second sheet;
  - (ii) grasping the uncoupled portion of the silicone band; and
- (iii) pulling the uncoupled portion of the silicone band so as to uncover the glue or adhesive tape strip and bind the two sheets together.
- 8. (amended) A method for aligning rectangular sheets to be permanently bound comprising (i) placing the sheets in a device that provides at least two adjacent projecting sides oriented at a 90 degree angle to each other and (ii) apposing the edges of the sheets with the NY02:326415.1

projecting sides of the device so that the corners of the sheets fitting within the edges of the device are superimposed.

- 9. (amended) A device for use according to claim 8, which further provides a silicone zone in an area corresponding to the glue or adhesive tape strip of the sheets, wherein the zone prevents attachment of a sheet to the device during binding.
- 10. (amended) An adhesive band to permanently bind loose sheets comprising a releasable\_silicone material support, having a substantially elongated shape alternately providing on one side portions provided with cold activated glue and shorter portions without glue.
- 11. (amended) The adhesive band according to claim 10 wherein the band is continuous and comprises sections which each comprise a portion provided with cold activated glue and a shorter portion without glue, and having, at the end of each section a feature selected from the group consisting of a cut facilitation, a breaking line, an optical signal and a mechanical signal to indicate a cutting point.
- 12. (amended) The adhesive band according to claim 10, wherein the function of the portion without glue is to provide the opportunity for an easy removal of the silicone support which after the application of the glue on the sheet has the function of preventing undesired adhesion prior to binding.
- 13. (amended) The adhesive band according to claim 10 wherein said band is wounded, the outer surface of the support band being preferably refractory to the glue.
- 14. (amended) The adhesive band according to claim 10 wherein the glue-providing portions have glue on two surfaces, one of which is destined to adhere to the sheet to be bound, the second one being destined to adhere to the sheet that during the binding will be coupled to the sheet providing the band.

  NY02:326415.1

- 15. (amended) The adhesive band according to claim 10 wherein said band is applied on both sides of a sheet.
- 16. (amended) The adhesive band according to claim 10 wherein said band is applied to a sheet by a method selected from the group consisting of manual application, application by a suitable device, and application by a printer.

Please add the following new claims:

- 17. (new) The sheet according to claim 2, wherein an adhesive strip is provided on an edge selected from the group consisting of an upper edge, a lower edge, and a lateral edge.
- 18. (new) The sheet according to claim 2, wherein an adhesive strip is close to the edge of the sheet.

### **REMARKS**

Claims 1-18 are pending.

The title and the claims are amended to more particularly state the subject matter of Applicant's invention.

The specification is amended to correct obvious typographical errors and to make the required claim of priority.

New claims 17 and 18 are added and claims 3 and 4 are amended to depend only from claim 1 (rather than claim 1 or claim 2) to eliminate multiple dependent claims.

None of the amendments constitutes new matter.

According to 37 C.F.R. §1.121(b)(1), pages containing the replacement paragraphs, showing amendments, are attached hereto.

NY02:326415.1

According to 37 C.F.R. §1.121(c)(1) pages containing the claims marked to show amendments are attached hereto.

None of the amendments contain new matter.

The claims are believed to be in a condition for allowance.

Respectfully submitted,

Ronald B. Hildreth PTO Reg. No. 19,498

Lisa B. Kole PTO Reg. No. 35,225

Attorneys for Applicant (212) 408-2500

### **CLAIMS SHOWING AMENDMENTS**

- 1. (amended) A sheet [Sheet prepared beforehand] for permanent [the] binding to one or more additional sheets, [characterised in that it provides a glue or both sides adhesive tape strip] having an adhesive strip comprising an adhesive element selected from the group consisting of a glue and a two-sided tape, wherein the tape is adhesive on both surfaces, along at least one of its edges[, or close to the same edge], and a silicone material band, [realasably] releasably placed on said glue or [both sides] adhesive tape strip and having at least a portion not coupled to said glue or [both sides] adhesive tape strip, such that the uncoupled portion may be used to grasp the silicone band during its removal and the binding.
- 2. (amended) The sheet [Sheet] according to claim 1, [characterised in that it provides said glue or both sides adhesive tape strip,] having an adhesive strip and a releasably placed [the relevant] silicone band [on both sides,] on opposite surfaces.
- 3. (amended) The sheet [Sheet] according to claim 1 [or 2, characterised in that the glue or both sides] wherein an adhesive [tape] strip [on the sheets] is provided on an edge selected from the group consisting of an upper [or] edge, a lower edge, and a lateral edge.
- 4. (amended) The sheet [Sheet] according to claim 1 [or 2, characterised in that], wherein an [the glue or both sides] adhesive [tape] strip [on the sheets] is close to the edge of the sheet [provided on a lateral edge].
- 5. (amended) The sheet [Sheet] according to claim 1 [one of the preceding claims, characterised in that said sheets are realised] as comprised in a continuous snap out of sequential sheets, provided with lateral dragging bands, wherein the uncoupled [said grasping] portion of the silicone band [being] is coupled by weakening lines with the band of the following sequential sheet.
- 6. (amended) The sheet [Sheet] according to claim 1 [one of the preceding claims, characterised in that said] wherein a portion of the silicone band is larger than said glue or [both sides] adhesive tape strip, and can be folded outwardly during [the] bonding, said portion of the silicone band larger than the glue or [both sides] adhesive tape strip being the [grasping] uncoupled portion.

NY02·326435.1

7. (amended) <u>A method for irreversibly binding at least two sheets</u> together, comprising:

(i) superimposing the sheet [Sheet] according to claim 1 [one of the preceding claims, characterised in that to make its binding, it is superimposed to other sheets to be bound, being them prepared or not according to the invention, and thus] over a second sheet; [the different projecting grasping portion are grasped and drawn at the same time to uncover the various glue or both sides adhesive tape strips]

- (ii) grasping the uncoupled portion of the silicone band; and
- (iii) pulling the uncoupled portion of the silicone band so as to uncover the glue or adhesive tape strip and bind the two sheets together.
- 8. (amended) A method for aligning rectangular sheets to be permanently bound comprising (i) placing the sheets in a device that [Device for packaging and binding sheets, characterised in that it] provides at least two [90°] adjacent projecting sides oriented at a 90 degree angle to each other [upon which resting the sheets to be bound] and (ii) apposing the edges of the sheets with the projecting sides of the device so that the corners of the sheets fitting within the edges of the device are superimposed.
- 9. (amended) A device for use [Device] according to claim 8, [characterised in that it] which further provides a silicone zone [in correspondence of] in an area corresponding to the glue or [both sides] adhesive tape strip of the sheets, wherein the zone prevents attachment of a sheet [to avoid that a sheet attaches] to the [same] device during [the] binding.
- 10. (amended) An adhesive [Adhesive] band to permanently bind loose sheets[, characterised in that it comprises] comprising a releasable silicone material support, having a substantially elongated shape [, slightly attachable by the glue, alternatively] alternately providing on one side portions provided with cold activated glue and shorter portions without glue.
- 11. (amended) The adhesive [Adhesive] band according to claim 10[, characterised in that said] wherein the band is continuous and comprises sections which each comprise a portion provided with cold activated glue and a shorter portion without glue, and having, at the end of each section [the support providing] a feature selected from the group consisting of a cut facilitation, [or] a breaking line [lines], [and/or] an

2

NY02.326435.1

optical <u>signal and a</u> [or] mechanical signal to indicate [the] <u>a</u> cutting point [to suitable apparatuses to automatically apply it on sheets].

- 12. (amended) The adhesive [Adhesive] band according to claim 10[ or 11], [characterised in that] wherein the function of the portion [portions] without glue is [that of being out of the sheet] to provide the opportunity [of] for an easy removal of the silicone support which after the application of the glue on the sheet has the function of preventing undesired adhesion prior to [protecting from eventual gluing not wished before the] binding.
- 13. (amended) <u>The adhesive</u> [Adhesive] band according to <u>claim 10</u> [one of the preceding claims 10-12, characterised in that] <u>wherein</u> said band is wounded, the outer surface of the support band being preferably refractory to the glue.
- 14. (amended) The adhesive [Adhesive] band according to claim 10 [one of the preceding claims 10-13, characterised in that] wherein the glue-providing portions have glue on two surfaces[said support provides both sides adhesive portions, i.e. a second support comprised of any suitable material providing glue on both sides], one of which is destined to adhere to the sheet to be bound, the second one being destined to adhere to the sheet that during the binding will be coupled to the sheet providing the band.
- 15. (amended) <u>The adhesive</u> [Adhesive] band according to <u>claim 10</u> [one of the preceding claims 10-14, characterised in that] <u>wherein</u> said band is applied on both sides of a sheet.
- of the preceding claims 10-15, characterised in that] wherein said band is applied to a sheet by a method selected from the group consisting of manual application, application [manually, or] by a suitable device, and application by a printer [provided along the path within the printer].

3

NY02 326435 1

# REPLACEMENT PARAGRAPHS SHOWING AMENDMENTS

Paragraph 80 at page 7 lines 5-8 of the specification is amended as follows:

-- In figures 14, 15 and 16 and 17 and 18, it can be seen the sheet 41 for continuous [continuous] feeding, wherein the glue or both sides adhesive tape strip 42, along with the silicone band 43, is provided on the upper side of the alternated sheets, instead of on the lateral edge. --

Paragraph 88 at page 7 line 35 through page 8 line 2 of the specification is amended as follows:

-- Whichever is its structure, band 201 according to the invention, preferably comprised of protection silicone material releasable by the various glues employed, provides a glue zone 202 to be placed on the sheet 203 (see figures 22 and 23 and 24) for coupling with the same in the application zone [104] 204 (see figure 25). --

Paragraph 89 at page 8 lines 3-7 of the specification is amended as follows:

-- On the continuous band 201, at the end of the glue zone 202, a zone 205 without glue is provided, for the subsequent removal of the silicone material band, followed by a zone [106] 206 serving to reveal, by apparatus or visually, the end of a band section and the beginning of the following one to be applied on another sheet 203.--